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IN THE

Supreme Court of the United States

OCTOBER TERM, 1963

No. 377

AMERICAN AIR FILTER COMPANY, INC.,
Petitioner,

v.

FARR COMPANY,
Respondent.

PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE NINTH CIRCUIT

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No. ____

AMERICAN AIR FILTER COMPANY, INC.,
Petitioner,

v.

FARR COMPANY,
Respondent.

PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE NINTH CIRCUIT

American Air Filter Company, Inc. petitions that a writ of certiorari issue to review a judgment of the United States Court of Appeals for the Ninth Circuit, entered May 17, 1963, reversing a judgment of the United States District Court for the Southern District of California which held Rivers Patent No. 2,807,330 valid and infringed.

OPINIONS BELOW

The opinion, findings and conclusions of the District Court are unreported and are printed in the Appendix hereto, *infra*, pp. 1a-28a. The opinion of the Court of Appeals, printed in the Appendix hereto, *infra*, pp. 29a-35a, is reported only at 137 U. S. P. Q. 627 (1963).

JURISDICTION

The judgment of the Court of Appeals was entered on May 17, 1963. The jurisdiction of this Court is invoked under 28 U. S. C. § 1254(1).

QUESTION PRESENTED

Does a Court of Appeals have the power to invalidate a patent for lack of invention by superposition of conditions and requirements for patentability in addition to those "conditions and requirements" for patentability expressly set forth in Title 35 of the United States Code?

CONSTITUTIONAL AND STATUTORY PROVISIONS INVOLVED

The eighth clause of Article I, Section 8 of the United States Constitution and Sections 101-103 and 282 of Title 35 of the United States Code are involved herein and are printed on a fold-out sheet following the Appendix hereto.

STATEMENT OF THE CASE

On September 2, 1958, petitioner brought an action against respondent for infringement of Rivers Patent No. 2,807,330 in the District Court for the Southern District of California.[1] Following the submission of extensive trial briefs, proposed findings of fact, a trial of six days' duration and oral argument of counsel, judgment was rendered for petitioner holding the patent valid and infringed.

The Rivers patent relates to ventilating air filters and automatic air filtering. The gist of the invention is the provision of an entirely new mode of manipulative operation for well known expansible compressible filter media (See Findings 38, 40, 46, 49, *infra*, pp. 18a-21a) and is expressed in method claim 2 as follows:

> 2. In a method of filtering from an air stream solids borne thereby, the steps consisting of progressively removing and expanding from a compressed supply web thereof an expansible-

[1] Jurisdiction was invoked under 28 USC § 1338(a).

compressible filter medium, moving the medium into and through said air stream and thereafter progressively recompressing the thus exposed medium, carrying the solids retained in it, into a disposable package.

The Rivers patent contains one additional method claim, two apparatus claims and a claim directed to a preformed package of filter medium. Claim 2 is exemplary, however, and it was conceded below and is petitioner's position here that if this claim is invalid for lack of invention, all the remaining claims are likewise invalid.

The Rivers invention, although in retrospect simple and easily understood, is possessed of most, if not all, of the classical judicially-recognized indicia of lack of obviousness and the presence of "invention". Specifically, the District Court found:

—a long standing problem in the art (Findings 26, 27, *infra*, pp. 14a-15a),

—a technological block in the minds of the skilled workers in the field (Finding 43, *infra*, p. 19a),

—unsuccessful prior attempts to solve the problems (Findings 22, 27, *infra*, pp. 11a-12a, 14a-15a),

—the availability, for over thirty years, of all the tools and knowledge utilized by Rivers in the conception and development of the invention (Finding 43, *infra*, p. 19a),

—a conception by Rivers under unusual circumstances (Finding 5, *infra*, p. 5a),[2]

[2]Which might be characterized as a "flash of genius" [*Cuno Engineering Corp.* v. *Automatic Devices Corp.*, 314 U. S. 84, 91 (1941)] if such criteria had not been explicitly rejected by Congress as a condition for patentability in the Patent Act of 1952. 35 U. S. C. § 103.

—the creation of an entirely new class of automatic air filters (Findings 40, 44, 45, *infra*, pp. 18a-19a) which avoided the disadvantages of the prior art units and provided new advantages and results not theretofore attained (Findings 26, 46, 47, 49, *infra*, pp. 13a-14a, 19a-21a),

—a spontaneous, immediate and widespread acceptance and demand by the trade, which was of a nature well qualified to independently judge the comparative utility and merit of the contribution (Findings 50-53, *infra*, p. 21a),

—the displacement of prior art devices (Finding 55, *infra*, p. 21a),

—and the admitted copying of the patented method by respondent because of the popularity of the invention with the trade and the demands of its sales representatives (Findings 8, 9, *infra*, p. 6a).

The District Court also expressly found that the prior art and arguments advanced by respondent were no better than or substantially different from the matters considered by the Patent Office (Findings 56, 59, *infra*, pp. 22a-23a); and that novelty in the form of a new mode of operation and new functions was present (Findings 40, 42, 48, 49, *infra*, pp. 18a, 20a-21a).

After having ascertained the requisite novelty required as a condition for patentability by 35 U. S. C. § 102, the District Court also found as a fact:

> None of the prior art upon which defendant relies teaches or discloses the inventions of the patent in suit, nor does it, taken alone or in combination, provide any teaching or disclosure that can be considered to render the inventions of the patent in suit obvious or apparent to those skilled in the art. Finding 60, *infra*, p. 23a.

Respondent duly filed an appeal on August 17, 1959 and, as indicated earlier, the Court of Appeals, after some delay, reversed on May 17, 1963.

Although the Court of Appeals reversed the District Court, it did not controvert the findings of fact below (*infra*, p. 32a) and in fact commented upon the basic lack of dispute as to the state of the prior art and the nature of the Rivers contribution (*infra*, p. 33a). It reversed solely for lack of invention and stated *the determinative issue* as follows:

> Whether Rivers' contribution is of sufficient novelty to be patentable is therefore a question of law, based upon the rule that a combination of old elements is patentable invention only if the elements take on some new quality or function by being brought into concert and their combination results in unusual or surprising consequences. (citing *Great Atl. & Pac. Tea Co. v. Supermarket Equip. Corp.*, 340 U. S. 147 (1959) and other cases.) *Infra*, p. 33a.

Insofar as method claim 2 is concerned, the Court of Appeals admitted the presence of "novelty" but found invalidity for lack of invention, despite the finding of new function and mode of operation (Finding 48, *infra*, p. 20a) as follows:

> Essentially Rivers' method consists of a series of steps in which an old filter material is manipulated in a new manner in an old filter apparatus to filter air. While the combination of operations was a good idea, we are unable to perceive that any of the requisite unusual or surprising consequences resulted. *Infra*, p. 34a.

The Court dismissed the classical indicia of the lack of obviousness as found by the District Court (*supra*, pp. 3-4) as "at the most weak reeds for a patentee to rely upon" (*infra*, p. 35a).

REASONS FOR GRANTING THE WRIT

This petition raises an important question of federal law and the scope of judicial power in relation thereto which has not been, but should be, decided by this Court.

A. The Present Patent Statute and Its Background

Patents in the United States exist only by virtue of statutes enacted by Congress pursuant to the enumerated power set forth in Art. I, § 8 of the Constitution. None of the predecessor statutes to the 1952 Act set forth any statutory "standard of invention" as a condition for patentability.[3] The requirement of "invention" was initially of judicial origin and had its genesis in *Hotchkiss* v. *Greenwood*, 52 U. S. (11 How.) 248 (1850). That decision introduced both the "requirement" of "invention" and set a "standard" therefor as follows:

> . . . for unless more ingenuity and skill in applying the old method . . . were required than were possessed by an ordinary mechanic acquainted with the business, there was an absence of that degree of skill and ingenuity which constitute essential elements of every invention. In other words, the improvement is the work of the skilful mechanic, not that of the inventor. 52 U. S. at 266.

Generally, in the ensuing years, this Court applied this standard of invention, albeit with some verbal variances. See, e.g., *Dunbar* v. *Meyers*, 94 U. S. 187, 197-200 (1876); *McClain* v. *Ortmayer*, 141 U. S. 419, 425-29 (1891); *Expanded Metal Co.* v. *Bradford*, 214 U. S. 366, 381 (1908);

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[3] See, e.g., Edwards, *Efforts To Establish A Statutory Standard of Invention*, Study No. 7, Subcomm. on Patents, Trademarks and Copyrights, Senate Comm. on the Judiciary, 85th Cong., 1st Sess. 1-2 (Comm. Print 1958); Frost, *The Patent System And The Modern Economy*, Study No. 2, Subcomm. on Patents, Trademarks and Copyrights, Senate Comm. on the Judiciary, 84th Cong., 2nd Sess. 47-60 (Comm. Print 1957).

Eibel Process Co. v. *Minn. & Ontario Paper Co.*, 261 U. S. 45, 63 (1923). In more recent years, however, the terminology and associated discursive comments employed by this Court relative to the delineation of the standards of invention in certain cases has differed markedly from that of earlier cases. See *Lincoln Co.* v. *Stewart Warner Corp.*, 303 U. S. 545, 549 (1938); *Cuno Engineering Corp.* v. *Automatic Devices Corp.* 314 U. S. 84, 91 (1941). Such terminology, coupled with the associated discursive comments in *Great Atl. & Pac. Tea Co.* v. *Supermarket Equipment Corp.*, 340 U. S. 147 (1950) posed serious questions as to whether the standard of invention was being judicially raised.

The cumulative effect of the above, when viewed in light of the proportion of patents that were being held invalid on reaching this Court in the period subsequent to 1935, was the creation of a situation that might be aptly described as unstable and which led to pointed commentaries by members of this Court over the role of the judiciary in the patent system as then extant. See *Jungersen* v. *Ostby & Barton Co.*, 335 U. S. 560, 568, 571-2 (1949).

At least in partial response to the above development, Congress, in the late 1940's, considered the enactment of a statutory standard of invention.[4] These efforts culminated in the enactment, in 1952, of §§ 101, 102 and 103 of Title 35 of the United States Code (printed on a fold-out sheet following the Appendix hereto).

As noted in both the Senate and House Reports on the subject legislation, "Section 101 sets forth the subject matter that can be patented, 'subject to the conditions and requirements of this title.' The conditions under which a patent may be obtained follow, and Section 102 covers the condition relating to novelty."[5] Section 102 significantly

[4] See Edwards, *supra* note 3, at 2-15.

[5] S. Rep. No. 1979, 82nd Cong., 2nd Sess. 5 (1952); H. R. Rep. No. 1923, 82nd Cong., 2nd Sess. 6 (1952).

uses mandatory language—"A person shall be entitled to a patent unless . . ."

The Senate and House reports also state:

> There are a number of changes in substantive statutory law. . . . The major changes or innovations in the title consist of incorporating a requirement for invention in § 103 . . .[6]

With respect to § 103, the Reports state:

> Section 103, for the first time in our statute, provides a condition which exists in the law and has existed for more than 100 years, but only by reason of decisions of the courts. An invention which has been made, and which is new in the sense that the same thing has not been made before, may still not be patentable if the difference between the new thing and what was known before is not considered sufficiently great to warrant a patent. That has been expressed in a large variety of ways in decisions of the Courts and in writings. Sec. 103 states this requirement in the title. It refers to the difference between the subject matter sought to be patented and the prior art, meaning what was known before as described in section 102. If this difference is such that the subject matter as a whole would have been obvious at the time to a person skilled in the art, then the subject matter cannot be patented.[7]

and as to the intent and purpose of Congress the Reports continue:

> That provision paraphrases language which has often been used in decisions of the Courts, and the section is added to the statute for uniformity and

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[6] *Id.*, S. Rep. at 4; H. R. Rep. at 5.

[7] *Id.*, S. Rep. at 6; H. R. Rep. at 5.

definiteness. This section should have a stabilizing effect and minimize great departures which have appeared in some cases.[8]

That the Congressionally selected standard of invention is that defined in § 103 is confirmed by the express wording of § 282 which enumerates defenses in patent actions and sets forth, as an invalidity defense which must be pleaded, *inter alia*: "Invalidity of the patent or any claim in suit on any ground specified in part II of this title *as a condition for patentability*" (Emphasis added). Reference to part II of Title 35 clearly shows that only §§ 102 and 103 are specifically entitled and delineated "Conditions for patentability".

It would seem quite clear from the foregoing that Congress has, in the Patent Act of 1952, for the first time enacted a specific statutory requirement for and standard of invention.

It is also submitted to be beyond argument that the Court of Appeals in the instant litigation did not measure the method claim of the Rivers patent against 35 U. S. C. § 103 but rather superimposed additional conditions and requirements for patentability of judicial origin upon those enacted by Congress in the Patent Act of 1952.[9]

B. The Scope of Judicial Power

It is the public interest which is dominant in the patent system. *Mercoid Corp.* v. *Mid-Continent Investment Co.*, 320 U. S. 661, 665 (1944). But the legislature is the prime

[8] *Id.*, S. Rep. at 6; H. R. Rep. at 5.

[9] For the purposes of this petition we reserve the obvious questions that arise as to the applicability of the test of *Great Atl. & Pac. Co.* v. *Supermarket Equipment Corp.*, 340 U. S. 147 (1950) to method claims generally or the applicability of such test or portions thereof to the particular claims here in issue in view of Finding 48 (*infra*, p. 20a).

guardian of the public interest. This was recognized in *Berman* v. *Parker*, 348 U. S. 26, at 32 (1957): "Subject to specific constitutional limitations, when the legislature has spoken, the public interest has been declared in terms well-nigh conclusive."[10] In the instant situation there can be no doubt that Congress *has spoken and has defined*, for the first time, a statutory standard of invention (*supra*, pp. 7-9).

It is settled law both as a general proposition and with respect to other enumerated powers of Congress, that where Congress has acted, judicial power is effectively limited to the determination of whether the legislature, in what it has prescribed, has gone beyond constitutional limits. In this determination the Court is not concerned whether the action taken was wise or expedient. *Gibbons* v. *Ogden*, 22 U. S. (9 Wheat.) 1, 196-7 (1824); *NLRB* v. *Jones & Laughlin Steel Corp.*, 301 U. S. 1, 46 (1936); *Helvering* v. *Davis*, 301 U. S. 619, 640 (1937); *Guaranty Trust Co.* v. *Henwood*, 307 U. S. 247, 259 (1939); *National Broadcasting Co.* v. *United States*, 319 U. S. 190, 219-20 (1943); *Polish Alliance* v. *NLRB*, 322 U. S. 643, 650-1 (1944); *United States* v. *Twin City Power Co.*, 350 U. S. 222, 224 (1956); *Railway Employe's Dept.* v. *Hanson*, 351 U. S. 225, 234 (1956); *Sinclair Refining Co.* v. *Atkinson*, 370 U. S. 195, 214-5 (1962).[11] It also recognized that the judicial power does not extend to engraftment to or superposition on legislative action. *Dewey* v. *United States*, 178 U. S. 510, 520-1 (1900); *Clark* v. *Paul Gray, Inc.*, 306 U. S. 583, 594 (1939); *Electric Battery Co.* v. *Shimadzu*, 307 U. S. 5, 14 (1939); *United States* v. *Bethlehem Steel Corp.*,

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[10]Cf. *Local 1976* v. *NLRB*, 357 U. S. 93, 100 (1958).

[11]See *United States* v. *Darby*, 312 U. S. 100, 115-6 (1940); *Southern Steamship Co.* v. *NLRB*, 316 U. S. 31, 43 (1942); *Wickard* v. *Filburn*, 317 U. S. 111, 120-1 (1942); *Secretary of Agriculture* v. *Central Roig Refining Co.*, 338 U. S. 604, 619 (1950); *United States* v. *Kahriger*, 345 U. S. 22, 29 (1953); *FTC* v. *Simplicity Pattern Co.*, 360 U. S. 55, 67-8 (1959); *Barenblatt* v. *United States*, 360 U. S. 109, 132 (1959).

315 U. S. 289, 309 (1942); *United States* v. *American Union Transport, Inc.*, 327 U. S. 416, 456-7 (1946).

In the case at bar, the Court of Appeals clearly did not limit the scope of its review of the District Court's holding to the determination of whether or not the Rivers patent satisfied the express statutory conditions and requirements for patentability as enacted by Congress in 35 U. S. C. § 102 and 103 but rather superimposed conditions and requirements for patentability upon those specified by the legislature. Petitioner submits that such action by the Court of Appeals was beyond the scope of judicial power and requires reversal by this Court.

C. The Importance Of The Question

As one aspect of an increasing concern in an era of rapidly increasing population and a declining rate of economic growth, recent years have witnessed a marked increase in analytical studies of the relationship of patents and the patent system to the economy. Although it has been long recognized that the economic philosophy behind the Constitutional empowerment of Congress to grant patents was the conviction that ". . . encouragement of individual effort by personal gain is the best way to advance public welfare through the talents of . . . inventors . . .[12]", these studies have revealed a growing re-awareness of the importance of the relationship between patents and risk capital, both generally, insofar as concerns research, development and production facilities and also specifically, as concerns the conception, formation and early growth of small businesses. Studies have been initiated and published by, among others, Congress[13] and private educational foundations.[14]

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[12] *Mazer* v. *Stein*, 347 U. S. 201, 219 (1954).

[13] See, e.g., Frost, *supra* note 3, at 5, 13, 15, 16, 19; Bush, *Proposals For Improving The Patent System*, Study No. 1, Subcomm.

Significantly included in such studies are indications of the mounting concern with the unsettled condition of the patent law, possible disillusionment due to the high mortality rate of patents and the uncertainty and expense incumbent

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on Patents, Trademarks and Copyrights, Senate Comm. on the Judiciary, 84th Cong., 2d Sess. 1-7, 18-19 (Comm. Print 1956); Machlup, *An Economic Review Of The Patent System*, Study No. 15, Subcomm. on Patents, Trademarks and Copyrights, Senate Comm. on the Judiciary, 85th Cong., 2d Sess. 21, 23-4, 36-8 (Comm. Print 1958); Abramson, *The Patent System: Its Economic And Social Basis*, Study No. 26, Subcomm. on Patents, Trademarks and Copyrights, Senate Comm. on the Judiciary, 86th Cong., 2d Sess. 1-3, 5-6, 11-12 (Comm. Print 1960); See also *Celebration Of The American Patent System*, A Complete Summary of the Proceedings in Observance of the One Hundred Twenty-Fifth Anniversary of the United States Patent Act of 1836, Washington, D. C., October 18-25 inc., 1961, 21-31 (1962).

[14]A relatively new source of information regarding the relationship of patents to the modern economy is the PATENT, TRADEMARK AND COPYRIGHT JOURNAL OF RESEARCH AND EDUCATION of the Patent, Trademark and Copyright Foundation of The George Washington University (hereinafter cited as J. R. E.). As to business and small business conception, formation and early growth in selected industries see *Proceedings of the First Public Conference of The Patent, Trade-Mark and Copyright Foundation*, 1 J. R. E. CONF. SUPP. 46, 135 (1957); *Proceedings of The Annual Public Conference of The Patent, Trademark, and Copyright Foundation*, 3 J. R. E. CONF. NUMBER 79 (1959); Harris, *A Patent Guide for Inventors and Executives, and the Context in Which it Appears*, 5 J. R. E. 310, 322-3 n. 37 (1961). As to research endeavors see Carr, *Our Patent System Works*, 4 J. R. E. 55, 68-71 (1960); Harris, *supra*, at 322 n. 37 (1961). As to comparative significance re size of business see Sanders, Rossman and Harris, *Patent Acquisition By Corporations*, 3 J. R. E. 217, 218 (1959); Strong and Markham, *Patents and Other Factors Affecting Executive Decisions*, 4 J. R. E. 49, 54 (1960); Carr, *supra*, at 70, 71; Harris, *supra*, at 315 n. 16, 323 n. 37. As to incentives and uncertainties related to risk capital see *Report of Attorney General's National Committee to Study the Anti-Trust Laws* 224-25 (1955); Mayers, *The United States Patent System in Historical Perspective*, 3 J. R. E. 33, 33 (1959). As to the rate of decline in patents issued relative to population in the United States during the last 30 years as compared to other industrial countries having a faster growth rate see, e.g. *The Proceedings of The Annual Public Conference of The Patent, Trademark, and Copyright Foundation*, 4 J. R. E. CONFERENCE NUMBER 57-66 (1960).

upon participants in patent litigation.[15] The focal point of trouble is not difficult to recognize. It is described in a recent Staff Report of the Subcommittee on Patents, Trademarks and Copyrights of the Senate Committee on the Judiciary:

> The annual reports of the subcommittee have noted the continuing gap between the views of the Patent Office and the U. S. courts as to what is and what is not patentable. No significant improvement in this situation has been observed since the enactment of section 103, which defines the standard of invention in the Patent Act of 1952. Viewed from the experience of the past 6 years, the statement in the Senate report of 1952 that section 103 "should have a stabilizing effect and minimize great departures which have appeared in some cases," appears unduly optimistic.
>
> Not only is the standard of invention clouded in uncertainty but the various circuits are unable even to agree as to the legislative intent expressed in section 103. One view holds that the standard of patentability was unchanged by the enactment of section 103, while the other position is that it was the intent of Congress to relax the rigid test of patentability laid down by the Supreme Court.[16]

Analyses of the situation by case compilation by circuit have been made by Congress[17] and by others.[18]

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[15]Bush, *supra* note 13, at 11-12, 18-19; Frost, *supra* note 3, at 58-60; STAFF OF SUBCOMM. ON PATENTS, TRADEMARKS AND COPYRIGHTS, SENATE COMM. ON THE JUDICIARY, 86TH CONG., 2D SESS., AN ANALYSIS OF PATENT LITIGATION STATISTICS iii, 1-2, 6 (Comm. Print 1961).

[16]AN ANALYSIS OF PATENT LITIGATION STATISTICS, *supra* note 15, at 1.

[17]Edwards, *supra* note 3, at 17-24; AN ANALYSIS OF PATENT LITIGATION STATISTICS, *supra* note 15.

[18]NOTE, 63 COLUM. L. REV. 306 (1963); Chin, *The Statutory Standard of Invention: Section 103 of the 1952 Patent Act*, 3 J. R. E. 317 (1959).

The most recent of these analyses takes the position that in the Courts of Appeal for the Second, Third and Fourth Circuits and the District of Columbia, 35 U. S. C. § 103 has been interpreted as relaxing the previously enunciated judicial standard of invention; that in the Courts of Appeal for the First, Fifth, Sixth, Eighth and Ninth Circuits, 35 U. S. C. § 103 has been interpreted as being a codification of all prior decisional law and hence introductory of no change in the standard of invention; and that the Courts of Appeal for the Seventh and Tenth Circuits have taken no discernible position.[19] Not surprisingly, prior analyses differ as to the position of the various circuits.[20] Still another unsettled area is whether invention is a question of law or fact.[21] One of the consequences of the confusion and uncertainty now extant has been the widespread invalidation of patents, particularly by appellate courts.[22] In this context; comments in the Staff Report (*supra*, note 15) are particularly appropriate: "On the other hand, the number of patent invalidations must be viewed with concern since usually it is the patents with the greatest prospect of commercial importance which are litigated."[23] "Any widespread disillusionment with the patent system could retard the flow of scientific information with a resulting danger to the rate of economic growth and the national security."[24]

The instant case is a recent example of the unsettled situation now extant. The Court of Appeals

—makes no mention of the statute.

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[19] NOTE, COLUM. L. REV. *supra* note 18, at 313-23.

[20] Chin, *supra* note 18; Edwards *supra* note 3.

[21] AN ANALYSIS OF PATENT LITIGATION STATISTICS, *supra* note 15, at 6-8.

[22] *Id* at 24.

[23] *Id* at 6.

[24] *Id* at 2.

—raises no point as to the propriety of the facts found below, but expressly holds that invention is a question of law;

—reverses the lower court and finds the method claims invalid, on the sole ground that no "requisite unusual or surprising consequences resulted" (*infra*, p. 34a)

—makes no comment as to the express finding of lack of obviousness below (Finding 60, *supra* p. 4)

—and dismisses the factual indicia upon which courts have long relied as evidence of lack of obviousness as "at the most weak reeds for a patentee to lean upon" (*infra*, p. 35a)

In contradistinction therewith and, as an example, the Court of Appeals for the Sixth Circuit holds that invention is a question of fact, *Maytag Co.* v. *Murray Corp. of America*, 137 U.S. P.Q. 819, 821 (1963) and places heavy reliance upon the findings of fact of the lower court including those relating to the indicia here dismissed as "weak reeds." See, e.g., *National Latex Products Co.* v. *Sun Rubber Co.*, 274 F. 2d 224, 239-40 (6th Cir. 1959).

It is submitted that the foregoing clearly demonstrates the importance of the question presented and the need for consistency of judicial action with respect to a branch of law intimately affecting economic growth.

CONCLUSION

For the foregoing reasons it is respectfully urged that this petition be granted.

Respectfully submitted,

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August 14, 1963

IN THE

UNITED STATES DISTRICT COURT

SOUTHERN DISTRICT OF CALIFORNIA

CENTRAL DIVISION

AMERICAN AIR FILTER COMPANY, INC., *Plaintiff*, *vs.* FARR COMPANY, *Defendant.*	Civil Action No. 858-58Y

DECISION

The above-entitled cause heretofore tried, argued and submitted is hereby decided as follows:

Judgment will be for the plaintiff that the patent in suit, United States Letters Patent No. 2,807,330, is good and valid in law and its claims are infringed by the defendant.

After Judgment shall have become final, question of damages will be referred to a Master, to be appointed by the Court.

Costs to the plaintiff. No attorneys' fees.

Findings and Judgment to be prepared by counsel for the plaintiff under Local Rule 7.

Comment

I am of the view that Patent No. 2,807,330 issued to R. D. Rivers on September 24, 1957, and duly assigned to the plaintiff is valid and infringed by the defendant's

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device. My only misgiving as to the validity of the Patent [155] arose as to Claim 2, which reads:

> "2. In a method of filtering from an air stream solids borne thereby, the steps consisting of progressively removing and expanding from a compressed supply web thereof and expansible-compressible filter medium, moving the medium into and through said air stream and thereafter progressively recompressing the thus exposed medium, carrying the solids retained in it, into a disposable package."

And it concerned the question whether the Claim was sufficiently distinct as required by Section 111 of Title 35 U. S. C. A. A study of the matter, in the light of the voluminous record made in this case convinces me that the particular Claim read with the details in the specifications has the certainty required by law. This being so, it follows that the other Claims have similar certainty.

In my view, Rivers taught the art something which is not found in the prior art and, especially, in the Patent to Christofferson, No. 1,982,639 issued December 4, 1934, which the defendant's expert claims to contain more of the features of the patented device than any other. The fact is that the defendant did not copy Christofferson, which was before the Patent Examiner, or any of the additional ones referred to at the trial. They claim to have embodied a device described by the plaintiff in one of its bulletins more than one year before the date of the application (35 U. S. C. A. §102(a)). I am convinced that the defendant copied the device described in the patent. And if the commercial device manufactured by the plaintiff deviated from that described in the Patent, the plaintiff was entitled to avail itself of the doctrine of equivalents because the de-

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vice described was only one of the modes [156] "contemplated by the inventor" for "carrying out his invention" (35 U. S. C. A. § 112).

Hence the ruling above made.

Dated this 2nd day of June, 1959.

/s/ LEON R. YANKWICH
Judge. [157]

[Endorsed] Filed June 2, 1959

IN THE

UNITED STATES DISTRICT COURT

SOUTHERN DISTRICT OF CALIFORNIA

CENTRAL DIVISION

AMERICAN AIR FILTER COMPANY, INC., *Plaintiff*, *vs.* FARR COMPANY, *Defendant.*	Civil Action No. 858-58Y

Findings of Fact, Conclusions of Law and Judgment

Pursuant to Rule 52 of the Rules of Civil Procedure, this cause having come on for trial before this Court on May 13, 1959 before the Honorable Leon R. Yankwich, District Judge, and Plaintiff and Defendant having presented their evidence and having orally argued in support of their respective contentions, and this Court having entered its Decision herein dated June 2, 1959, and having directed counsel for Plaintiff to prepare Findings of Fact, Conclusions of Law, and Judgment pursuant to the provisions of Local Rule 7, the same are hereby adopted by the Court as its Findings of Fact, Conclusions of Law, and Judgment: [169]

FINDINGS OF FACT

1. Plaintiff corporation is, and has been for many years, a manufacturer and seller of various air filters, dust collectors, and of air filtering and dust collecting systems.

2. Defendant corporation is, and has been for some years, a manufacturer and a seller of various air filters and air filtering systems.

3. The United States Patent in suit, No. 2,807,330, was issued to Plaintiff on September 24, 1957 as the assignee of the patentee, Richard D. Rivers; since that date Plaintiff has been and still is the owner of said patent.

4. Plaintiff has placed the required statutory marking on air filtering apparatus manufactured and sold by it under said United States Patent No. 2,807,330 since the date of issuance thereof.

5. Mr. Richard Rivers, a young physicist of very limited experience in the field of air filtration, conceived the patented inventions in January, 1953 while observing, as an onlooker, certain tests being performed by others in Plaintiff's research laboratory and with which tests he had no connection or responsibility. [170].

6. After Rivers demonstrated that the patented inventions could be practically attained, the design of commercial units embodying the same was undertaken by Plaintiff's Development Department.

7. The patented inventions were thereafter embodied in commercial air filters manufactured and sold by Plaintiff. These filters were then and, for the most part, are now identified to the trade by Plaintiff as "Roll-O-Matic" filters. The initial sales to the trade of the Roll-O-Matic filter, known as the Model A, commenced in early 1954. The initial sales of a redesigned Roll-O-Matic filter, known as Model

B, to the trade commenced in December of 1956. Both the Model A and Model B Roll-O-Matic filters are constructed and operate in accordance with the teachings of the patent in suit and come within the scope thereof.

8. Defendant saw Plaintiff's "Roll-O-Matic" filter literature, and the methods described therein at least as early as the middle of 1956 and thereafter took steps to build and market a virtual copy thereof.

9. Defendant's infringement of the patent in suit was caused by the popularity of plaintiff's patented filters with the trade and by the demands of the Defendant's sales representatives for such a product [171].

10. Defendant first sold its infringing filters in January, 1957.

11. Defendant's copying of Plaintiff's filter and methods brought immediate success to Defendant and by November, 1958 Defendant had sold about 250 units.

12. The filtering of air, or other gas, to remove solid particulate matter borne thereby, is an old and crowded art.

13. Air borne solid particulate matter is broadly classified as "atmospheric dust" and "process dust". "Process dust" refers to all particulate matter generated by or associated with some industrial process. It is usually homogeneous in character, frequently covers a rather narrow range of particle sizes and usually occurs in high concentrations. The collection of lint in textile mills and paper dust and ink mist in newspaper press rooms are two ex-

amples of process dusts. "Atmospheric dust" refers to a complex mixture of particulate matter commonly found in the atmosphere for the particular area or location in question. It generally covers a wide range of particle sizes, occurs in relatively low concentrations and is quite heterogeneous in nature. Its constituents vary with the geography of the location, the season of the year, the wind direction and other general factors. A sample of atmospheric dust at any one point will generally contain particles of practically every material common to the locality together with other wind borne particulate matter originating in distant places. Typical constituents may include [172] minute particles of clay, silica, soot and carbon, decayed animal and vegetable matter, organic plant fibers, lint, pollen, mold spores, bacteria and other microorganisms. Atmospheric dust particles will range from submicron sizes, such as smokes, up to particles at the threshold of visibility, about 50 microns. There are 25,400 microns to the inch.

14. The problems encountered in removing atmospheric dusts from air are different from those encountered in the removal of process dusts. The removal of atmospheric dust from the air is a specialized art and the devices used to effect the removal of such atmospheric dust are known to those skilled in this art as "ventilating air filters".

15. The heart of a ventilating air filter is the filter medium. The filter medium is a structure or thing designed to allow the air to pass but to hold and retain such solid particulate matter as it is desired to remove from the air stream. To effect the desired filtering action in a ventilating air filter, the air is positively driven through the

filter medium and the dirt particles borne in the air are caused to contact the surfaces of the filter medium and to be retained thereby. Ventilating air filters for the removal of atmospheric dust have been broadly classified by the art in accordance with their operating characteristics and principle of operation as "viscous impingement type" filters, "dry type" filters, and "electrostatic type" filters. The choice of a particular type of ventilating air filter for effecting the removal of atmospheric dust depends upon a number of factors which include the desired degree of dust removal and pertinent practical and economic considerations [173].

16. The classical differences generally expressed by the separation of ventilating air filters into "viscous impingement type," "dry type" or "electrostatic type" by the art are as follows:

> "Viscous Impingement type" air filters generally use the higher range of conventional air velocities through the media—these being in the order of 300 to 500 feet per minute. They have a moderate order of effectiveness in the removal of the dust and a high order of dust holding capacity per unit of media area, all of which is quite satisfactory for many purposes. The media employed in such filters is generally formed of elements spaced relatively widely apart and in such wise as to give the media appreciable effective depth. Such configurations offer a relatively low resistance to air flow through the media and provide a high air handling capacity. The surfaces of the media elements are generally liberally coated or treated with some viscous material (often referred to as "oil") which serves to positively retain and hold dust particles which im-

pinge on the coated or treated surface (i.e., in the manner of "fly paper").

"Dry type" air filters generally use, and are limited to, the lower range of air velocities—these being in the order of 10 to 100 feet per minute. They possess a relatively high order of effectiveness in the removal of dust and a generally low dust holding capacity per unit of media area. The media employed in such filters is generally formed of small elements spaced closely together to provide a dense mat-like structure with tortuous air paths therethrough and, generally, the elements are arranged in dense sheets of moderate or small depth. These configurations lend an inherent high resistance to air flow [174] through the media and so limit air handling capacity. The surfaces of the elements forming the media are generally not treated with a viscous or oily substance, although in some instances small amounts of oil are employed to enhance performance.

"Electrostatic type" ventilating air filters, which were introduced about 1937, utilize an electrostatic force, rather than the driving action of the air, to effect impingement of the dust particle on the filter medium.

Filters which employ media which have been liberally coated or treated with a viscous or oily substance are often loosely called "viscous impingement filters". Those which do not utilize filter media which has been so coated or treated are often loosely called "dry" filters. In addition the term "dry" has been loosely used in other connotations, such as denoting an automatic viscous impingement type filter characterized by the absence of a bath or tank of oil.

17. Ventilating air filters c both the "viscous impingement type" and the "dry type" are further sub-classified by the art into "unit" or "automatic" air filters and each of these sub-classifications are further sub-divided into "permanent" types and "disposable" types in accordance with whether the particular media employed was reconditionable by cleaning or whether it was thrown away and replaced by fresh unused media.

18. In the past 30 to 40 years many substances and structures have been proposed as filter media, but the practical art has generally used the following types of media: [175]

—metal-membered media built up of metal plates, screens, wires or sheets

—filamentous media such as animal hair, metallic wool, glass fibers and, sometimes, vegetable fibers in kinked or shredded form

—paper, woven cloth or fabric felts and the like.

19. Regardless of whether an air filter is, or was, characterized as a "viscous impingement type" or "dry type" filter, air filters always present the problem of cleanliness in the sense that as the atmospheric dust accumulates on the filter medium during the filtering of the air there comes a time when the resistance to the flow of air, caused by this dirtying of the filter medium, increases beyond practical limits and, therefore, it becomes desirable to clean or renew the filter medium. This cleaning or maintenance problem, which is as old as the art of air filtering, involves maintenance, the possibility of improper maintenance or

untimely maintenance and, further, usually necessitates the shutting down of the air filter during the cleaning or renewal process.

20. Prior to about the middle 1920's the viscous impingement type and dry type filters commercially used in the filtering of atmospheric dust from air were largely of the "fixed", "panel", "cell", or "unit" type (hereinafter called "unit" type), these terms all denoting the fact that cleaning or renewing of the filter medium was not automatic but was accomplished by the shutting down of the filtering process at intervals to effect manual cleaning or replacement of the dirty filter medium. [176]

21. In or about 1926 there first commercially appeared in this country the so-called "automatic" air filters. These were machines so designed as to automatically clean, renew or replace the filter medium, the objective being to decrease the day by day maintenance and attention, and to prevent, to a considerable extent, the necessity of shutting down the filtering process.

22. The automatic "dry type" of ventilating air filter is exemplified by the Mickle, Dollinger, Wolthuis, Birkholz and Christofferson patents, which were cited during the Patent Office prosecution of the patent in suit. These patents do not disclose the patented inventions or provide any teaching that might be considered to render the patented inventions obvious or apparent to those skilled in the art. These automatic "dry type" filters proved commercially unsuccessful as ventilating air filters for the removal of atmospheric dust, due to inherent air flow limitations and consequent limited air handling capacity where the media was disposed

in a straight line across the air stream, and the practical difficulties of effecting the presentation of extended areas of filter media surface to the air stream in the air filtering zone by zig-zagging or pleating thereof.

23. The only true "dry type" automatic machines operating today are used for the collection of process dust. The conventional type usually employs a bag or cylinder of a dense felted or fabric media and is cleaned by beating or blowing the accumulated process dust off the media surface from time to time. Another atitomatic machine which has been loosely and inappropriately termed a "dry type filter" and which is in successful [177] operation today in the collecting of certain large sized process dusts in limited applications, such as textile mill lint and press room ink mist, employs an extremely thin, flimsy disposable paper filter media of a hybrid character that is, because of its porosity and thinness, devoid of practical utility in the filtering of atmospheric dust in the general ventilating field. Such a lint collector has, since 1950, been sold by plaintiff under the name "Auto Air-mat".

24. Plaintiff's "Auto Air-mat" unit, apart from being devoid of practical utility in the removal of atmospheric dust from air, did not, and does not, incorporate the inventions of the patent in suit nor did it provide any teaching that might be considered to render the patented inventions obvious or apparent to those skilled in the art.

25. The automatic ventilating air filters of the viscous impingement type of the prior art proved to be commercially successful as ventilating air filters; from a time starting in or about 1926 and extending to date, there

have been sold, and commercially used, automatic viscous impingement type air filters which operate on the following principles: the filter medium is made of metal-members such as plates, wire screens, sheets or the like; a tank or bath of viscous or oily liquid is associated with the filter and provides a reservoir from which the desired viscous material may be applied to the surfaces of the metal-membered filter medium; and the "automatic" feature is provided either by means for moving the metal-membered filter medium on an endless track into and through the oil bath or tank, thereby to simultaneously remove at [178] least a portion of the dirtied oil from the surfaces of the medium and to renew those surfaces with a coating of fresher oil, or, the metal-membered filter medium is fixed and from time to time the dirtied surfaces thereof are cleaned and renewed with fresh oil by flushing or otherwise causing oil to move across the fixed surfaces of the medium. Filters constructed according to these principles have been utilized for over thirty years in the automatic filtering of atmospheric dust from air. Such devices have been, and presently are, manufactured and sold by many of the manufacturers of air filtering equipment, including both the plaintiff and the defendant.

26. The disadvantages of the use of such automatic viscous impingement type filters utilizing metal-membered filter media and, in conjunction therewith, a bath or tank of oil, were and had been, well known to the art. Such disadvantages arose in large part from the presence of the oil bath and of liquid oil and included: periodic removal of a messy oil-dirt sludge from the filtering operation; maintenance and inspection to insure that the oil was being properly applied to the filter media; difficulties and expense caused

by the maintaining of, or failure to maintain, the many mechanical moving parts; requirements often made by the Fire Underwriters that fire prevention systems be installed because of the presence of large volumes of oil; periodic inspection is required to insure that oil levels are maintained in the oil bath or tank, that water or other liquid impurities are not present in the oil tank in harmful amounts and that the type of oil desirable for best operation is used for replacement; problems, caused by the probability that the air, in passing through the filter medium, would remove from [179] the surfaces of that medium excess oil which would be entrained or carried by the air to contaminate some product or area contacted by the filtered air; and periodic manual cleaning of the filter media made necessary, or desirable, by physical entanglement of dust or dirt in the metallic media in such wise that it is not removed by the normal application of fresh oil to the surfaces of the media. Additional drawbacks of such filters included excessive weight arising from their metallic construction and necessary appurtenances such as tanks and pumps; and the fact that such filters could not readily be placed in other than a vertical position because of the necessity of maintaining the oil levels and oil flow.

27. The principle upon which the automatic viscous impingement-type filters used by the art prior to Rivers' invention operated had been known for over 25 years. Despite the known disadvantages of such filters, these various automatic viscous impingement type filters developed and offered to the trade during this period differed only in design detail and involved no new principles of construction or operation. In that period of over 25 years the development of automatic filters had reached a plateau, in the

sense that the workers in the art worked to improve the constructional details of units operating on old principles and developed no new approach to the subject.

28. The development, in about 1926, and, thereafter, the use of these successful automatic viscous impingement type ventilating air filters of the metal-membered medium—oil tank variety did not eliminate the use of the "unit" filters, whether of the "viscous impingement type" or of the "dry type". Each of these [180] various types of ventilating air filters has, in the years since 1926, sought its own level, that level being primarily determined by the needs and desires of the user. However, because of their automatic features, the automatic viscous impingement type filters came to be used by many who had problems concerning the removal of the larger particles of dirt from relatively large quantities of air.

29. In the period prior to 1954[1] the "unit" type of air filter used as filter medium all of the types of media previously mentioned above in Finding No. 18.

30. Throughout a period of at least twenty years prior to Rivers' conception, disposable unit filters of the viscous impingement type used pads of filamentous filter media of appreciable effective depth having high air handling capacity and large dust holding capacity. These thick pads were inexpensive, were readily fabricated and presented a large effective surface area which could be liberally coated or otherwise treated with a viscous or oily substance and

[1]The date of commercial introduction of the invention of the patent in suit.

included pads formed of animal hair, certain vegetable fibers, metallic wools and glass wools.

31. Among these relatively thick pads of filamentous materials which had long been used as filter media in viscous [181] impingement type unit filters before 1954 were a group which had expansible-compressible properties in the sense that they were resilient and would, when compressed for an interval, return, upon release of compression, to their approximate original thickness. The expansible-compressible properties of such filter media had long been recognized. As early as 1925, it had been recognized that the expansible-compressible properties of such materials could be useful in "unit" types of filters where it was desirable to compress the media during use and to later expand it for cleaning.

32. These relatively thick pads of expansible-compressible filter media used in the "unit" type filters were available to the industry from a very early date. The expansible-compressible properties of these materials were well known and were also utilized in fields other than air filtering. Thick pads or webs of animal hair had widespread use as upholstery material, as well as for air filters. Thick pads or webs of glass fibers had widespread use as house and sound insulation and as resilient pads, as well as for air filters. Metallic wools were commonplace for many uses, as well as for air filters.

33. In the period prior to 1954 the glass fibered filter media became the most popular of the disposable or "throw away" filamentous media because of its relative cheapness; because glass is relatively inert to chemical influence, is fireproof and is light in weight [182]

34. The expansible-compressible filter media and the specified properties thereof as described and identified in the specification of the patent in suit were, and are, clearly descriptive of a well known and recognized class of filter materials having expansible-compressible properties, and are such as to enable those skilled in the art to readily identify and use the same. The specific example set forth in the specification clearly describes an example of the filamentous glass material, which, by 1954, had largely commercially displaced other suitable materials for the reasons set forth in Finding No. 33. Any person skilled in the art would have had no difficulty in identifying, obtaining and using, in 1954 or today, the filter media described by way of specific example in the specification of the patent in suit.

35. The well known and recognized class of materials referred to in Findings 31, 32 and 34 is adequately and distinctly expressed in the claims by the terms "expansible-compressible filter medium", "expansible-compressible web" and "permeable expansible-compressible integral web which will return to an expanded state when released from a compressed state".

36. Until Mr. Rivers' invention was commercially offered to the trade in 1954 by plaintiff, the expansible-compressible filter media had only been used in the unit type of air filter.

37. Mr. Rivers did not, by his invention, develop any new filter medium but, instead, merely used the well known expansible-compressible [183] filter media which had long previously been available and which, for many years, had been used in the non-automatic "unit" type of air filters.

38. In its preferred form the method of the Rivers' patent includes providing a supply of the expansible-compressible media in compressed roll form, progressively expanding the media off this roll and across the air stream and then progressively rewinding and compressing the media, and its contained solids, into another roll which eventually may be conveniently thrown away. This is the form in which plaintiff commercially offered the Rivers' invention to the public in 1954 and this is the form in which defendant appropriated the invention.

39. There was nothing new in the concept of placing a web of filter media in roll form and feeding this web from its supply roll across the air stream to be filtered, and thereafter, rerolling the dirty web into a roll which could be thrown away. Such devices had been suggested many times over the thirty year period preceding Mr. Rivers' invention.

40. Mr. Rivers was the first to propose the novel mode of manipulation of the previously well known expansible-compressible filter media, as set forth in the method claims of the patent in suit, to produce a new class of automatic filters and to, thereby, make possible the commercial use of the cheap filamentous expansible-compressible filter media in automatic air filtering. [184]

41. There was nothing new in winding webs on mandrels for the purpose of convenience in handling and storing.

42. Mr. Rivers was the first to propose that a web of expansible-compressible filter media be formed into a com-

pressed roll on a mandrel and be used as a pre-formed filter media cartridge or package as a direct supply of media for automatic air filtering operations.

43. From all the facts it appears that for many years the experienced workers in the air filtering art had available to them all of the tools, and all of the basic knowledge used by Mr. Rivers in 1953 in arriving at and carrying out the concepts of his invention. The commerical rewards following from Mr. Rivers' concepts were extensive. In the light of these facts the simplicity of Rivers' concept points to the existence of technological block in the minds of the experienced workers of the art which was not removed until he pointed out the way.

44. The inventions of the patent in suit have created a new class of automatic ventilating air filters.

45. The inventions of the patent in suit have made available for the first time a commercially practical automatic ventilating air filter of the disposable media type [185].

46. As a result of Rivers' invention, the commercial art of filtering has available, for the first time, a novel, highly practical and useful mode of operation for automatically utilizing the cheap, efficient filamentous filter media of the expansible-compressible type which had long proved to be so useful in the non-automatic types of air filters.

47. The advantages flowing from the use of Mr. Rivers' invention are the following:

(a) For the first time, the useful, cheap and well proven expansible-compressible filamentous media formerly used in non-automatic filters has become conveniently available to automatic filtering.

(b) The filtering art has been provided with an alternative to the long employed automatic viscous impingement type filters which used metal-membered media and oil tanks and is, thus, in a position to avoid the disadvantages of the older type automatic filters in such instances where such disadvantages are unwanted or not tolerable.

(c) An automatic viscous impingement type filter and filtering method have been provided which, if desired, will operate for periods of many months and up to as long as a year without attention.

(d) The air filtering art is for the first time possessed of a method by which the inconvenience, and uncertainties attendant upon maintenance and interrupted performance is reduced to a minimum.

48. Mr. Rivers' inventions as described and claimed in the patent in suit include a new mode of operation and the clothing of apparatus elements with new functions.

49. The patentee has provided an entirely new mode of manipulative operation and thereby has effected an old result i.e. the filtering of air, in a novel way which eliminates procedural disadvantages previously suffered in automatic air cleaning. The patentee's invention brings no improved result insofar as the cleaning of the air is concerned because the old filter media which is subjected to the

patentee's new mode of manipulative operation does not, thereby, become enhanced in its air cleaning properties.

50. The customers to whom filters are sold are, for the most part, of a type well qualified to independently judge the usefulness of the product.

51. The response of the trade to the patented inventions was spontaneous, immediate and substantial. There was immediate widespread acceptance and demand for the invention.

52. Automatic viscous impingement type air filters embodying Mr. Rivers' invention were an immediate success. In the first two years of their introduction plaintiff sold about $1,800,000 worth of such filters. In the period up to January, 1959, plaintiff sold more than 12,000 sections for a total gross sales [187] value of over $8,000,000.

53. The commercial success of plaintiff in marketing air filters embodying Mr. Rivers' invention took place without the help of more advertising than plaintiff normally expended on any of its many air filter products.

54. The patentee's invention has been successful despite the fact that it does not necessarily effect its automatic air cleaning result at an operating cost lower than that previously encountered in obtaining an equal result of air cleaning by the previously used automatic machines. Often the use of the patentee's invention increases the operating cost.

55. The patented inventions are displacing the automatic viscous impingement type ventilating air filters of the prior art.

56. The prior art, and other material, upon which defendant relies for its defense of invalidity, is, in all material respects, the same as, or is not substantially different than, the prior art known by, and the admissions of fact considered by, the United States Patent Office prior to the grant of the patent in suit. [188]

57. The arguments advanced by defendant contra the validity of the patent in suit, are in all material respects the same as, or similar to, the matters considered by the United States Patent Office prior to the grant of the patent in suit.

58. The Patent Office Examiner who handled the application for the patent in suit also concurrently handled an application for patent on plaintiff's "Auto-Airmat" unit and affidavits filed in the latter application clearly showed that "Auto-Airmat" units were made and sold long prior to one year before the filing of the application for the patent in suit.

59. The Patent Office was in no way misled by the applicant or his attorneys during the prosecution of the application for the patent in suit. In fact the following admissions made by the applicant before the Patent Office Examiner are as good, or better, than any of the prior art upon which the defendant has relied:

> "The gas filtering art is not a new one; it is, in fact, a crowded art in which much effort has been expended over a long period of time in devising apparatus by which large volumes of gas could be cleaned by devices requiring a minimum of maintenance cost and attention. Expansible-compressible

> filter media have long been known in this art. The principle of passing a filter medium from one point to another point and, intermediate thereof, through a filtering area is certainly an old concept. Yet it appears that only the applicant has thought to use a method or apparatus in which the expansible-compressible material is first compressed into a packaged supply, is thereafter released from that supply, expanded, passed through the filtering area and thereafter recompressed or otherwise conditioned to a readily disposable state. In so doing, applicant has removed expansible-compressible filter media from its restricted use as a fixed filter into a sphere where it can be conveniently, automatically and progressively presented to a filtering job thus fully and effectively utilizing the highly desirable properties of such media." [189]

60. None of the prior art upon which defendant relies teaches or discloses the inventions of the patent in suit, nor does it, taken alone or in combination, provide any teaching or disclosure that can be considered to render the inventions of the patent in suit obvious or apparent to those skilled in the art.

61. The defendant did not copy the prior art but rather copied the device described and claimed in the patent in suit.

62. Defendant makes and sells a preformed package of filter medium for use in its "Roll Kleen" filters. This preformed package consists of a web of about 70 feet of permeable glass fiber filter media convolutely wound upon a mandrel member sized and arranged for direct insertion into the "Roll Kleen" filter. The media has an expanded thickness of 2 to 3 inches and is wound in compressed con

dition upon the mandrel into a roll of about 13 inches in diameter with the convolutely wound layers thereof being about 15/100 of an inch in thickness. The media is of such character as to return to its expanded state when released from its compressed state. This preformed package corresponds both in form and substance with Claim 1 of the patent in suit and said claim is infringed thereby.

63. In the operation of the defendant's "Roll Kleen" filter an expansible-compressible filter medium (of the character set forth in Finding No. 62) is progressively removed from a compressed supply web thereof, moved into and through an air stream in expanded condition and, after exposure in the air stream to accumulate air [190] borne contaminants, is thereafter progressively recompressed into a convolutely wound roll to form a disposable package thereof. This operation corresponds both in form and substance with the subject matter of method Claims 2 and 3 of the patent in suit and each of said claims is infringed thereby.

64. Defendant's "Roll Kleen" filter employs, as a filter medium, an elongate permeable expansible-compressible integral web that will return to an expanded state when released from a compressed state (of the specific character set forth in Finding No. 62). The "Roll Kleen" filter includes a frame defining an air filtering area and a passage for air through said area, a housing disposed at one side of the air filtering area to receive and locate a supply of precompressed filter medium and defining a supply zone, a second housing located to receive the filter medium at a point beyond said air filtering area and defining a discharge zone with said two housings defining, with said air filtering area a path of filter medium advance. The "Roll Kleen"

filter includes a rewind mandrel and a motor drive and associated controls therefor that serves to progressively displace the precompressed medium in the supply zone from its compressed state, through said air filtering area and into the discharge zone. Also included is a backing strip of Leno-weave cloth on the media which cooperates with the driven rewind mandrel to effect a compression of the expanded media on said mandrel as the same is convolutely rewound thereon and to thereby progressively condition the media into a disposable state. This structure and operation corresponds both in form and substance with the subject matter of apparatus Claims 4 and 5 of the patent in suit and each of said claims is infringed thereby [191].

65. The structure and operation of defendant's Type H Roll Kleen is the same as that set forth in Findings Nos. 62-64 for the standard Roll Kleen filter except that the media is moved in a horizontal rather than a vertical path. The structure and operation of the Type H Roll Kleen corresponds both in form and substance with the subject matter of Claims 1-5 of the patent in suit in the same particulars as set forth in the above mentioned findings and each of said claims is infringed thereby [192].

CONCLUSIONS OF LAW

A. United States Letters Patent No. 2,807,330 in suit was duly and legally issued to Plaintiff, American Air Filter Company of Louisville, Kentucky; said Plaintiff is the owner of the entire right, title, and interest in and to said Letters Patent, together with any and all rights of action, claims or demands arising out of or accruing from past infringement thereof.

B. United States Letters Patent No. 2,807,330 complies fully with all of the provisions of Title 35, United States Code, discloses and claims a patentable invention, and is not anticipated by any prior art.

C. United States Letters Patent No. 2,807,330 is good and valid in law as to all of the claims thereof; said patent claims cover a new and meritorious invention.

D. United States Letters Patent No. 2,807,330 constitutes a marked advance in the art and is entitled to a liberal construction of its terms.

E. Defendant has infringed Claims 1 through 5 of United States Letters Patent No. 2,807,330 by the manufacture and sale of its "Roll Kleen" filters.

F. Defendant has infringed Claim 1 of United States Letters Patent No. 2,807,330 by its manufacture and sale of initially installed media and replacement media for its "Roll Kleen" filter.

G. Plaintiff is entitled to a judgment for an injunction and accounting with costs as prayed for in the Complaint filed herein.

JUDGMENT

In accordance with the foregoing Findings of Fact, and Conclusions of Law, it is

Ordered, Adjudged, and Decreed:

I. That United States Letters Patent No. 2,807,330 was duly and legally issued on September 24, 1957, and is good and valid in law.

II. That Plaintiff, American Air Filter Company, Inc., is the owner of said Letters Patent, together with all rights of action for infringement thereof.

III. That Defendant, Farr Company, has infringed said Letters Patent by the manufacture and sale of its "Roll Kleen" filter and initially installed and replacement media therefor.

IV. That Plaintiff have judgment on its Complaint for infringement of said Letters Patent, as prayed for [194].

V. That a writ of permanent injunction issue out of and under the seal of this Court in usual form enjoining Defendant and its officers, agents, servants, employees, and attorneys, and those persons in active concert or participation with them from infringing said United States Letters Patent No. 2,807,330.

VI. That Plaintiff recover from Defendant general damages adequate to compensate for said infringement by Defendant, together with interest; and that this cause be referred to Theodore Hocke, Esq. as Special Master

for an accounting to ascertain such damages and report the same to this Court, said appointment to be effective only after interlocutory judgment has become final through determination on appeal or failure to appeal.

VII. That Plaintiff recover from Defendant, and have execution for, its taxable costs in the amount of $937.34.

Dated this 22nd day of July, 1959.

/s/ LEON R. YANKWICH,
United States District
Judge. [195]

Acknowledgment of Service Attached [196].

[Endorsed]: Filed July 22, 1959. Entered July 23, 1959

UNITED STATES COURT OF APPEALS

For the Ninth Circuit

Farr Company, a Corporation, *Appellant*, vs. American Air Filter Company, Inc., a Corporation, *Appellee*.	No. 16,668 May 17, 1963

Appeal from the United States District Court for the Southern District of California Central Division

---

Before:

Stephens, Jertberg and Koelsch, *Circuit Judges*.

Koelsch, *Circuit Judge*:

This appeal involves United States Letters Patent No. 2,807,330, issued to plaintiff, American Air Filter Company, assignee of Richard D. Rivers, the inventor.

In this opinion the parties will be referred to by their designations in the District Court. Plaintiff brought this action for infringement against the Farr Company, seeking damages and an injunction. Defendant urged as defenses anticipation and lack of invention, as well as overclaim and indefiniteness and uncertainty of the patent claims. Judgment went for the plaintiff and defendant has appealed. We conclude that the judgment must be reversed and the action dismissed.

Opinion

The Rivers' patent relates to a device for filtering air. It contains five claims; they define a roll of filter webbing, a method of manipulating the webbing in a roll-type filter, and a filter apparatus. Specifically, Claim One claims a preformed supply roll consisting of a strip of "expansible-compressible" webbing tightly wound so as to be compressed to less than half its expanded thickness on a mandrel or spool. Claims Two and Three claim the method for progressively removing and expanding from the supply roll the "expansible-compressible" web, moving it through an air stream and thereafter progressively recompressing and winding the used web onto a take-up spool to form a disposable package; and Claims Four and Five claim a means to condition and manipulate the webbing in the manner specified in Claims Two and Three.

The roll filter described in the Rivers' patent is similar in construction and operation to the familiar roll film photographic camera, in which a length of unexposed film, wound on a spool, is advanced section by section over the camera's light chamber, exposed, and then wound onto a take-up spool for removal. Such filters were not new in the art; indeed it appears that they were the subject of patents long prior to Rivers' invention and that plaintiff itself had manufactured and sold them.

Defendant argues that the phrase, "expansible-compressible," used in the patent to characterize and describe the filter web is meaningless; but for the purposes of this appeal we assume that the term adequately defines a relatively thick, resilient, loosely structured, filamentous web made of animal hair, vegetable fiber, metallic and glass wools, and like materials. Such webs permit the passage of air at high velocity and, due to their bulk, present a

large effective surface area to screen solids and other foreign matter from the air stream; they are very efficient and for many years have been commonly used in unit filters. The unit filter is much less convenient than the roll filter; the former makes no provision for a supply of filter material contained on a spool but employs a single section of webbing, rigidly held in a frame or cell, which must be manually replaced at relatively frequent intervals.

However, defendant vigorously argues that Rivers' invention was anticipated, because "expansible-compressible" webbing had been previously proposed for the roll as well as the unit filter. The record shows that the Christofferson Patent No. 1,982,639 for a roll filter specifies webbing composed of "very finely carded cotton fiber" which is "loosely felted" and "of exceptionally low resistance to the passage of air therethrough while at the same time having maximum efficiency in removing impurities." And another roll filter patent, Dollinger No. 2,016,991, also describes a material of "extremely fine fibers of paper, cotton, wool, asbestos, etc, lightly held together to form a relatively thick filtering medium in a very loose or porous condition." In addition, plaintiff's own roll filter marketed under the name "Auto-AIRMAT" used a thin diaphanous paper which may have been expansible-compressible."*

But the trial court found that issue against the defendant. It further found that the prior art taught only less efficient filter media in roll filters; those tightly structured which, although effective to screen smaller solids unduly

*Defendant's expert witness testified without contradiction that actual tests showed that the mere winding on the supply spool caused Auto-AIRMAT paper to be compressed to less than one-half its expanded state, precisely the degree of compression specified in the Rivers' patent

checked the flow of air, and those loosely structured which passed air at high velocity but were too thin to present an adequate screening surface. We accept these factual findings without pausing to critically examine into their validity.

It thus appears that, in defining a method of filtering air by using webbing, concededly old, in an apparatus which was likewise old, Rivers did contribute something to the art; he achieved in one filter the cleaning efficiency of the unit filter and the automatic feature of the roll filter.

Of course, without some mechanical alteration, the old roll-type filter would not accommodate the substitute material. "Expansible-compressible" filter material is resilient and automatically expands to normal thickness when unwound from the supply spool, but to recompress the used web into a disposable roll of convenient size, it must be tightly wound and the tension necessary to accomplish this latter operation causes the web to stretch and narrow or "neck". Necking in the filtering zone causes the edge of the web to retract from the guideways through which it travels, permitting the passage of contaminated air. To prevent this the Rivers' patent describes a power driven "hold-down" roller and plate located between the take-up spool and the air filtering zone; together the roller and plate grasp the moving web in somewhat the same fashion as a washing machine wringer and prevent the pull exerted by the take-up roll from being translated to the section of web that is being used. In addition, "expansible-compressible" filter material is of loose composition and tends to be displaced into a concave shape and to be blown apart by the force of the rapidly moving air stream. To provide needed support the Rivers' patent describes an endless porous conveyor belt positioned against the upstream face of the web.

Opinion

There is a presumption of validity which arises from the opinion of the patent office and is strengthened by the concurrence of the District Court. But, here the state of the prior art and the nature of the Rivers' contribution are for the most part undisputed, and in the areas where a dispute does exist we have assumed the facts in plaintiff's favor. Whether Rivers' contribution is of sufficient novelty to be patentable is therefore a question of law, based upon the rule that a combination of old elements is patentable invention only if the elements take on some new quality or function by being brought into concert and their combination results in unusual or surprising consequences. *Great Atl. & Pac. Tea Co.* v. *Supermarket Equip. Corp.*, 340 U. S. 147 (1950); *William T. Alzarado Sales Co.* v. *Rubaloff*, 263 F. 2d 926 (9th Cir. 1959), *cert. denied*, 360 U. S. 910 (1959); *Stearns* v. *Tinker & Rasor*, 220 F. 2d 49 (9th Cir. 1955), *cert. denied*, 360 U. S. 830 (1955); *Photochart* v. *Photo Patrol, Inc.*, 189 F. 2d 625, 627-28 (9th Cir.), *cert. denied*, 342 U. S. 867 (1951). The responsibility for the determination of that question is ours and we cannot abdicate to another court or agency. *Kwikset Locks, Inc.* v. *Hillgren*, 210 F. 2d 483, 487-88 (9th Cir. 1954), *cert. denied*, 347 U. S. 989, 348 U. S. 855 (1954).

"The function of a patent is to add to the sum of useful knowledge. Patents cannot be sustained when, on the contrary, their effect is to subtract from former resources freely available to skilled artisans. A patent for a combination which only unites old elements with no change in their respective functions, such as is presented here, obviously withdraws what already is known into the field of its monopoly and diminishes the resources available to skillful men." *Great Atl. & Pac. Tea Co.* v. *Supermarket Equip. Corp.*, *supra* at 152-53.

Surely the compressed supply roll of "expansible-compressible" webbing, which was the subject of Rivers' first patent claim, does not satisfy the strict requirement laid down by the Supreme Court. There was nothing unusual or surprising about such a roll, for, long before Rivers conceived his invention this particular kind of webbing was not only known and in general use for filtering air, but was commonly wound in tight rolls to facilitate handling and storage. The Rivers' patent taught the winding of webbing on a spool in the usual way that elongate strips of any material are wound on spools and here it is clear that neither the web nor the spool took on new qualities or functions by being so brought into concert.

Likewise Claims Two and Three, the method claims of the patent, do not meet the standards of invention. Essentially the Rivers' method consists of a series of steps in which an old filter material is manipulated in a new manner in an old filter apparatus to filter air. While the combination of operations was a good idea, we are unable to perceive that any of the requisite unusual or surprising consequences resulted. See *Kalich* v. *Paterson Pac. Parchment Co.*, 137 F. 2d 649 (9th Cir. 1943). Indeed, the appellee expressly acknowledged and the court found that the invention "brings no improved result insofar as the cleaning of the air is concerned because the old filter media which is subjected to the patentee's new mode of manipulative operation does not thereby become enhanced in its air cleaning properties."

The means was no better than the method. The structural weakness of loosely compacted webbing and its tendency to stretch under tension were well known facts. What was required was the addition to existing means of elements

to counteract these characteristics. We are satisfied that it was obvious to a skilled mechanic that such ordinary devices as the hold-down roller and the conveyor backing would meet this problem. Their adaptation to the roll filter did not require an exercise of the inventive faculty.

Plaintiff emphasizes that the filtering of air is an old and crowded art; that although there was a long-felt want for a filter embodying the advantages of the Rivers' device, none of the skilled mechanics of the art had done more than improve constructional details of prior devices; and that the patented filter met with prompt commercial success and even partially displaced prior art devices. Plaintiff argues that these facts all constitute clear indicia of invention. But, as one court has said with respect to commercial success, such factors are "at the most weak reeds for a patentee to lean upon." *McCord Corp.* v. *Beacon Auto Radiator Co.*, 193 F. 2d 985, 989 (1st Cir. 1952). They may tip the scales in favor of invention where the question is close and the court in doubt, but where invention is clearly lacking they do not make for patentability. *Altoona Publix Theatres, Inc.* v. *American Tri-Ergon Corp.*, 294 U. S. 477, 488 (1935); *Paramount Publix Corp.* v. *American Tri-Ergon Corp.*, 294 U. S. 464, 474 (1935); *Photochart* v. *Photo Patrol, Inc.*, 189 F. 2d 625 (9th Cir. 1951).

Our determination that there has been no invention makes it unnecessary to pass on the other issues. The judgment of the District Court is reversed.

(Endorsed) Opinion Filed May 17, 1963.

Frank H. Schmid, Clerk

THE CONSTITUTIONAL PROVISION

Art. 1, sec. 8. The Congress shall have power . . . To promote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries.

EXCERPTS FROM TITLE 35, UNITED STATES CODE

§ 101. Inventions patentable.

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

§ 102. Conditions for patentability; novelty and loss of right to patent.

A person shall be entitled to a patent unless—

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent, or

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States, or

(c) he has abandoned the invention, or

(d) the invention was first patented or caused to be patented by the applicant or his legal representatives or assigns in a foreign country prior to the date of the application for patent in this country on an application filed more than twelve months before the filing of the application in the United States, or

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or

(f) he did not himself invent the subject matter sought to be patented, or

(g) before the applicant's invention thereof the invention was made in this country by another who had not abandoned, suppressed, or concealed it. In determining priority of invention there shall be considered not only the respective dates of conception and reduction to practice of the invention, but also the reasonable diligence of one who was first to conceive and last to reduce to practice, from a time prior to conception by the other.

§ 103. Conditions for patentability; non-obvious subject matter.

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

§ 282. Presumption of validity; defenses.

A patent shall be presumed valid. The burden of establishing invalidity of a patent shall rest on a party asserting it.

The following shall be defenses in any action involving the validity or infringement of a patent and shall be pleaded:

. . . .

(2) Invalidity of the patent or any claim in suit on any ground specified in part II of this title as a condition for patentability . . .

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IN THE

Supreme Court of the United States

October Term, 1963

No. 377

AMERICAN AIR FILTER COMPANY, INC.,

Petitioner,

vs.

FARR COMPANY,

Respondent.

Brief for Respondent in Opposition to Petition for Writ of Certiorari.

This case comes before this Court on a Petition by American Air Filter Company, Inc., plaintiff below, for a Writ of Certiorari to review the Judgment of the United States Court of Appeals for the Ninth Circuit holding invalid Rivers Patent No. 2,807,330.

Question Presented.

The single question presented by the Petition is whether or not the court below erred in holding as a matter of law that the Rivers patent is invalid for want of invention.

Statement of the Case.

The present case is an ordinary patent infringement action involving a patent in the crowded field of air filtration. No particular public interest is involved and no conflict of decisions regarding the validity of the

patent exists. Indeed, the United States District Court for the Western District of Kentucky has also held the patent invalid for lack of invention in a recent decision in *American Air Filter Company, Inc. v. Continental Air Filters, Inc.* (Civil Action No. 3534), as yet unreported.

The Rivers patent describes and claims a method and apparatus for filtering solids such as dust from an airstream. As stated in the opinion of the Court of Appeals (318 F. 2d 500 at 501, Pet. p. 30a), the patented filter is a roll type filter, similar in construction and operation to the familiar roll film photographic camera. In the filter, a length of clean, compressible filter media is wound on a roll or spool, is advanced section by section through the airstream and then wound onto a take-up roll for removal. Such filters are admittedly old in the art:

> "There was nothing new in the concept of placing a web of filter media in roll form and feeding this web from its supply roll across the air stream to be filtered, and thereafter, rerolling the dirty web into a roll which could be thrown away." (Finding 39, Pet. p. 18a).

The filtering media described in the patent is also old in the art:

> "Mr. Rivers did not, by his invention, develop any new filter medium, but, instead, merely used the well known expansible-compressible filter media which had long previously been available and which, for many years, had been used in the non-automatic 'unit' type of air filters." (Finding 37, Pet. p. 17a).

Petitioner urged below that the combining of these old elements results in a "new mode of manipulation" of the filtering media. This alleged new mode merely constitutes compressing the media on the supply and take-up rolls and permitting it to expand when in the airstream. It is accomplished simply by tightly winding the media on the rolls, the media, of course, expanding to its normal depth when unconfined in the airstream. Petitioner's witnesses admit that the only result accomplished by so compressing the media is that of saving space [R. 502-504, 298-300, 680, 705]. As to this, the District Court found:

> ". . . . The patentee's invention brings no improved result insofar as the cleaning of the air is concerned because the old filter media which is subjected to the patentee's new mode of manipulative operation does not, thereby, become enhanced in its air cleaning properties." (Finding 49, Pet. pp. 20a-21a).

Argument.

The petitioner appears to urge that the Court of Appeals erred in holding the Rivers patent invalid for want of invention because it applied the standard of invention set forth by this Court in *Great Atl. & Pac. Tea Co. v. Supermarket Equipment Corp.*, 340 U. S. 147, 95 L. Ed. 162. In this, petitioner argues that Title 35 U. S. C. Sec. 103 relaxes such standard. Respondent submits that the patent is clearly invalid as lacking invention without regard to this question.* It

*Respondent contended below and still contends that the patent is invalid on several additional grounds not passed upon by the Court of Appeals. These are anticipation, claim indefiniteness and overclaiming.

represents the improvident granting of a monopoly over tightly winding a known compressible filter media in a known filter not to produce improvement in the filtering operation but merely to save space.

Conclusion.

The opinion of the Court of Appeals for the Ninth Circuit raises no issue required to be reviewed by this Court. This is an ordinary patent infringement action in which the Court of Appeals has held the patent invalid for lack of invention. The patent owner is simply dissatisfied with this holding.

It is respectfully submitted that the Petition should be denied.

LYON & LYON,
By RICHARD E. LYON,
Attorneys for Respondent.

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IN THE

Supreme Court of the United States

OCTOBER TERM, 1963

No. 377

AMERICAN AIR FILTER COMPANY, INC.,
Petitioner,

v.

FARR COMPANY,
Respondent.

REPLY BRIEF FOR PETITIONER

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IN THE

Supreme Court of the United States

OCTOBER TERM, 1963

AMERICAN AIR FILTER COMPANY, INC., *Petitioner*, v. FARR COMPANY, *Respondent*.	No. 377

REPLY BRIEF FOR PETITIONER

Respondent's Brief in Opposition is nothing but a rather obvious attempt at diversion and avoidance, effected through a self-serving recasting of the question presented coupled with a self-serving and erroneous characterization of the nature of the invention so as to bring the same into close conformity with certain fact findings relative to the state of the art as found below. The fact that Respondent felt it necessary to engage in such a transparent effort at diversion and avoidance only emphasizes the error of the Court below and the fundamental and important nature of the basic question presented.

The only point raised by Respondent meriting specific reply is its reference to the "recent decision in *American Air Filter Company, Inc.* v. *Continental Air Filter, Inc.*, —"[1] which was rendered by the Kentucky District Court *after the filing of the Petition herein.*[2]

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[1] *American Air Filter Co.* v. *Continental Air Filter, Inc.*, Civil No. 3534, W. D. Ky., August 20, 1963.

[2] Actually, only a memorandum opinion was rendered on August 20, 1963; judgment has not yet been entered.

This Kentucky action was tried, after submission of pretrial briefs and proposed findings of fact, in the week of May 25, 1959, immediately following the District Court trial of the instant case, after which extensive briefs were filed by both parties.

Despite the fact that this Kentucky action was against a different filter and different infringer and presented an extensive factual record which varied, at least in several important particulars, from that of the instant case, the Kentucky District Court withheld decision for over *four years* pending the outcome of the appeal to the Ninth Circuit in the instant case and then, in the memorandum opinion of August 20, 1963, succinctly stated the sole basis for its holding of invalidity as follows:

> "The ruling and reasoning in the opinion of Farr Co. v. American Air Filter Co., supra, is adopted as the law of this case."

As will be now apparent the Kentucky District Court has done nothing more than extend the error of the Court of Appeals for the Ninth Circuit.[3]

Apart from the above, the action of the Kentucky District Court in resolving the issue of validity in the manner and under the conditions stated and apart from the factual record made at trial only serves to emphasize the importance of the question presented and the need for its resolution by illustrating one immediate consequence of the improper extension of judicial power in the instant case by the Court of Appeals for the Ninth Circuit.

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[3] In the now very unlikely event that a conflict might later arise and be resolved by this Court in the patentee's favor, serious questions would then be presented as to the existence and nature of the patentee's possible rights against Respondent. Cf. *John Simmons Company* v. *Grier Brothers Company*, 258 U. S. 82 (1922); *Scotten* v. *Littlefield*, 235 U. S. 407 (1914).

The above matters constitute still further reasons why the Petition herein should be granted.

Respectfully submitted,

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